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REMARKS

Response to Election/Restrictions

The Examiner has set forth a restriction to one of the following inventions under 35 U.S.C. §121:

I. Claims 35-38, 44-101, 107 and 108 drawn to a biopsy site marker and a system for delivering a biopsy site marker, classified in class 600, subclass 431.

II. Claims 102-106, drawn to a method for marking a biopsy cavity, classified in class 600, subclass 28.

In response to this restriction requirement, Applicants hereby elect to prosecute claims 35-38, 44-101, 107 and 108 drawn to a biopsy site marker and a system for delivering a biopsy site marker.

Response to Claim Rejections Under 25 U.S.C. §103

Claims 35-38, 50-52, 55 and 59-64 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Fulton, III et al. (6,270,464), in view of Yamamoto (U.S. Pat. No. 4,847,049) and further in view of Foerster et al. (6,228,055).

In the rejection of these claims the Examiner contended that Fulton, III et al. teaches that the marker may be both ultrasonically and radiographically detectable, citing Col. 3, lines 56-59. Applicants believe that the Examiner has misinterpreted the reference. The cited passage indicates that the radiographic detectability may be enhanced by a radiopaque marker and the ultrasonic detectability by be enhanced by special treatment of the bioresorbable element. The cited passage fails to teach at least one marker body being radiographically detectable and at least one marker body being ultrasonically detectable as required by the claim. The teaching of Fulton, III et al. is directed to a palpable marker which may contain a radiopaque marker for radiographic detection or may have properties to aid detecting by ultrasound. See Column 6, lines 38-41. In other words, the radiographic detection and the ultrasonic detection in Fulton, et al. are mutually exclusive. Importantly, the entire Fulton et al. reference is directed to a single marker and the patent makes no reference to multiple markers, particularly multiple markers within a tubular delivery member.

The Examiner relies on Yamamoto for teaching the use of a metallic ion bound to the bioabsorbable material. However, Yamamoto fails to suggest a marker with a metallic ion bound thereto to facilitate radiographic detection. Those skilled in the art would not look to a biocide coating (as described by Yamamoto) for radiographic detection. Importantly, Yamamoto fails to make up for the deficiencies of Fulton, III et al. in that there is no suggestion of having a plurality of markers within a delivery tube and particularly where at least one of the markers is radiographically detectable.

The Examiner also relies upon Foerster et al. for teaching a plurality of biopsy markers within a cannula (tube 54). However, these markers are deployed at separate sites. Moreover, the reference fails to suggest a plurality of marker bodies with at least one being radiographically detectable and at least one being ultrasonically detectable.

Claim 62 calls for an ultrasonically detectable body of bioresorbable material with a radiopaque element with a loop and a free end embedded within the body. There is no suggestion of this combination provided in the cited references. The free ends of the loop element of Foerster et al. is designed to engage the wall of the cavity to fix the element within the cavity. If this loop element was embedded within a bioresorbable body the free ends would not perform this function, so there would be no suggestion to combine the references as contended by the Examiner.

Claims 44, 53, 54 and 56-58 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Fulton, III et al. ('464), in view of Foerster et al. ('055). The Examiner contends that the claims differ from Fulton, III et al. call for ultrasonically and radiographically detectable bodies. However, claim 44 calls for at least one body which is ultrasonically detectable and at least one body which has colorant. Fulton III et al. refers to aiding visual detection by adding colorant and enhancing ultrasonic detection by special treatment. No mention is made to at least one marker body having a colorant and at least one marker body having enhanced ultrasonic detectability.

Claims 45, 53 and 59 call for at least one marker body being radiographically detectable and at least one marker body being ultrasonically detectable, but as discussed above neither Fulton III et al. nor Foerster et al. teach or suggest these combined features.

Claims 45-49 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Fulton, III et al. ('464), in view of Yamamoto ('049) and further in view of Foerster et al. ('055). However, there is no suggestion from Yamamoto to provide radiographic detectability by securing a radiographically detectable metallic ion to the bioabsorbable material of at least one marker body which providing at least one marker body being ultrasonically detectable. Yamamoto secures a metallic ion to bioresorbable material to prevent infections. There is no suggestion in Yamamoto of adding the metallic ion for remote detectability.

Claims 65-101 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Fulton, III et al. ('464), in view of Foerster et al. ('055) and further in view of Voegele et al. (U.S. Pat. No. 6,220,248) with or without additional references. However, these claims require the marker bodies to be discharged by slidably moving the bodies up the ramp. Voegele refers to a ramp, but in this instance the marker bodies are not slidably moved up the ramp as required by the rejected claims.

Conclusions

Applicants believe that the pending claims are directed to patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance of the claims are earnestly solicited.

Respectfully submitted,

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